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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SUBSEA SERVICES INTERNATIONAL, INC.

Appeal 2013-002802
Reexamination Control 90/010,812
Patent 6,402,201 B1
Technology Center 3900

Before JEFFREY B. ROBERTSON, DANIEL S. SONG and
MICHAEL L. HOELTER, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Subsea Services International, Inc. (Appellant and Patent Owner) has filed a request for reconsideration and rehearing under 37 C.F.R. § 41.52 (hereinafter “Req. Reh'g.”), dated July 8, 2013, of our decision mailed May 8, 2013 (hereinafter “Decision”). Appellant requests rehearing of our Decision sustaining the rejection of claims 1-12 under 35 U.S.C. § 103(a).

We do not modify our opinion.

THE REQUEST FOR REHEARING

A request for rehearing must state with particularity the points believed to have been misapprehended or overlooked. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the briefs are not permitted in the request for rehearing. *See* 37 C.F.R. § 41.52(a)(1). Also, a request for rehearing is not an opportunity to merely express disagreement with a decision without setting forth points believed to have been misapprehended or overlooked. The proper course for an Applicant dissatisfied with a Board decision is to seek judicial review, not to file a request for rehearing to reargue issues that have already been decided. *See* 35 U.S.C. §§ 141, 145.

Baker discloses that “if desired, high density foam material may be injected into the annular space formed by the plastic sheet around the pipe P and allowed to set-up or form in place.” Baker 4:21-24.

In rejecting the claims, the Examiner found that Baker teaches that the “annular space between the exposed pipeline and the cover material [is] filled with a joint filling material of a high density foam (col. 4, lines 21-

24).” Final Rej. 4. The Examiner reiterated that Baker discloses “the injection of high density foam material into the annular space formed by the plastic sheet (30) around the pipe (P) and allowed to set-up or form in place (col. 4, lines 20-24).” Adv. Act. 3.

Appellant seeks a rehearing arguing that the Board overlooked the Examiner's erroneous finding regarding Baker which “improperly broaden[ed] the scope of the Baker disclosure to imply that the injection of high density foam material into the annular space is meant for an area *completely surrounding* the pipe P (*i.e.*, to fill an upper portion of the annular space formed by the plastic sheet around the pipe P).” Req. Reh'g. 4.

ANALYSIS

Appellant “submits that Baker clearly describes injection of the high density foam into the annular space *beneath* the pipes, in a manner similar to that formed by the high impact material 16 placed *beneath* the pipes.” Req. Reh'g. 4. Appellant contends that Figures 2 and 3A of Baker “illustrate the only orientations for the high impact material 16 (or the high density foam material) contemplated by Baker at the time of the invention.” Req. Reh'g. 5. Despite these contentions directed to the high density material being limited to a location *beneath* the pipe as shown, Appellant nevertheless acknowledges that Baker’s “high density foam material possibly could expand into the upper portion of the annular space” as well but contends that one skilled in the art would understand “that the foam material of Baker would not have completely filled the annular space.” Req. Reh'g. 8.

Appellant's acknowledgement of other areas (rather than just *beneath* the pipe) into which the foam could expand is consistent with Baker's express teaching that "[t]he fill material may be configured in a "C" shape or some other configuration to substantially fill the area." Baker 2:9-11.

Hence Baker's teaching is, as Appellant acknowledges, not limited to "only" the orientations or configurations depicted in Figures 2 and 3A (i.e., "*beneath*" the pipe), but that Baker's fill may also "expand into the upper portion of the annular space." In essence, while Appellant acknowledges that Baker's foam is not limited to only being located *beneath* the pipe, Appellant seeks this rehearing due to the Examiner "improperly broaden[ing] the scope of the Baker disclosure to imply that the injection of high density foam material into the annular space is meant for an area *completely surrounding* the pipe P (i.e., to fill an upper portion of the annular space formed by the plastic sheet around the pipe P)." Req. Reh'g. 4.

We note that the claims on appeal only specify that the annular space be "filled with a joint filling material," not that it be "completely" filled as now asserted. We further note that in a different limitation within each of the independent claims, Appellant specifically recites a pliable material "completely enclosing" the pipe joint, but no such similar limitation of "completely" is recited with respect to filling the annular space. As the Examiner notes, "[a]lthough the claims are interpreted in light of the specification, limitations from the specification are not read into the claims." Adv. Act. 4.

Accordingly, and based on the recited claim limitation, we address this rehearing to ascertain whether the Examiner's finding improperly broadened Baker to satisfy the limitation of an annular space that is “filled with a joint filling material.”

As indicated *supra*, Baker discloses that “high density foam material may be injected into the annular space formed by the plastic sheet around the pipe P and allowed to set-up or form in place.” Baker 4:21-24, *see also* Final Rej. 4, Dec. 4. Baker also provides instruction as discussed above that “[t]he fill material may be configured in a “C” shape or some other configuration to substantially fill the area.” Baker 2:9-11.

In view of Baker’s disclosure of injecting foam into the annular space, and Appellant’s acknowledgement that Baker’s high density foam can extend into the upper portion of the annular space, Appellant’s contentions that Baker’s teaching is restricted to only such filler being located “*beneath*” the pipe are not persuasive. Req. Reh'g. 4-8. As such, the Examiner did not improperly broaden Baker to satisfy the limitation of an annular space that is “filled with a joint filling material” as claimed. Appellant does not persuade us of Examiner error or of any error in our Decision.

Even assuming arguendo that filling of the annular space means complete filling as Appellant contends, Appellant’s own Background indicates that it was already known to one skilled in the art to fill the space between the pipe and the sheet. Spec. 1:48-50 (“[t]he space between the pipe and sheet metal was then filled.”). Thus, in view of (a) Baker’s teaching of fill shapes other than “C” shaped “to substantially fill the area,” (b) Appellant’s acknowledgement that Baker’s fill can expand into an upper

portion of the annular space, and (c) Appellant's discussion regarding the known procedure of filling the annular space, Appellant does not persuade us of error in the obviousness rejection, especially when one skilled in the art was already aware of injecting foam around the pipe.

Appellant also contends that Baker's high density foam material is injected around the pipe "*prior to*" forming the sealed annular space. Req. Reh'g. 7-8. However, this contention of injection prior to annular space formation conflicts with Baker's clear teaching that the fill material is injected into an *already existing* annular space. Baker 4:21-24. Further, as we previously stated, "[t]he Examiner's rejection relies on injection of the foam through an aperture in the sheet which forms an annular space" (Dec. 7) and Appellant does not show how this assessment is incorrect. Appellant's contention is not persuasive.

Appellant also references "comparative experimental results" that were submitted for review by the Examiner. Req. Reh'g. 8. However, the unpersuasiveness of these exhibits was discussed in the Decision. Dec. 12-13. Appellant presently contends that the submitted exhibits indicate that "the foam material of Baker would not have completely filled the annular space" as evidenced by these experiments. Req. Reh'g. 8. However, this contention is not persuasive because one such test was conducted employing 100% fill with the comment being that the foam "expanded out of the sleeve which prevented the sleeve from being sealed after the injection". App. Br. Exhibit 1, pg. 2. Hence, if anything, the experiment shows (a) that the sleeve was completely filled, and then some and, (b) as addressed in the Decision, that the experiment did not involve injection into an annular space

in accordance with the Examiner's combination of Baker and Isherwood. Dec. 13, *see also* Adv. Act. 30. More succinctly, the Examiner found that "[t]he abovementioned experiments did not include the placement of an aperture in the plastic sheet (30) of Baker as modified by Isherwood; therefore, the experimental protocol does not address the combined teachings of the prior art that is being used to reject the claims." Adv. Act. 30. We agree with the Examiner's assessment (Dec. 13) and accordingly, Appellant's conclusion that "Baker is incapable of retaining a high density foam material injected therein" is not persuasive. Req. Reh'g. 9.

Accordingly, in consideration of the evidence, we are not persuaded that the Examiner's reliance on Baker and the findings directed to the location of the high density foam material are in err.

DECISION

Appellants' Request has been granted to the extent that we have reconsidered our Decision in light of the arguments in Appellants' Request, but is denied with respect to our making any modification to the Decision.

No period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

DENIED

Appeal 2013-002802
Reexamination Control No. 90/010,812
Patent 6,402,201 B1

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